

REMARKS/ARGUMENTS

The rejection presented in the Office Action dated March 10, 2009, (hereinafter Office Action) has been considered but is believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses the § 103(a) rejection based upon the teachings of U.S. Publication No. 2005/0175973 by Miller (hereinafter “Miller”) as modified by those of U.S. Patent No. 6,655,586 to Back *et al.* (hereinafter “Back”) because the asserted references alone, or in combination, do not teach or suggest each of the claimed limitations. Specifically, neither of the asserted references teaches at least radio frequency tags including software instructions relating to an operation described in a user manual where an electronic device, in response to machine reading at least one of those radio frequency tags, executes the software instructions read from the at least one radio frequency tag to perform a device operation that is described in the user manual, as claimed in each of the independent claims. The Office Action acknowledges that Miller at least does not teach or suggest a device “operable, in response to machine reading at least one of the plurality of radio frequency tags attached in the user manual, to execute the software instructions. . . .” In an effort to overcome this deficiency, the teachings of Back are relied upon. However, this reliance is improper since Back also fails to at least teach executing “software instructions read from said at least one radio frequency tag to perform a device operation that is described in the user manual in connection with said at least one radio frequency tag”. Back merely teaches that pages of a book embed an identifying tag. The tag only identifies the page of the book and does not include any software instructions. Any dynamic content associated with a page of the book is stored and controlled by the page management system 500, not in the page identification tags (Col. 2, lines 60-65). Since neither of the asserted references teaches at least executing software instructions read from radio frequency tags in a user manual to perform a device operation described in the user manual, as claimed, any combination thereof must also fail to teach such limitations.

In addition, the asserted references have not been shown to teach several other claim limitations. For example, neither of the asserted references has been shown to teach a user manual associated with an electronic device. Rather, Miller and Back are directed to textbooks and books, respectively, where neither has been shown to be a user manual associated with an electronic device as claimed. Similarly, the asserted “software instructions” of Miller are not related to an operation described in the textbook (asserted as corresponding to the claimed user manual). Rather, the asserted software instructions of Miller merely cause a device to display additional information (Abstract, Fig. 3). Moreover, it has not been shown that the plurality of page identification tags of Back are readable without interference from other page identification tags in Back’s book, as claimed. Without correspondence to each of the claimed limitations, the § 103(a) rejection is improper.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); and moreover, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See, e.g.*, MPEP § 2143.03. The limitations directed to at least executing software instructions read from the at least one radio frequency tag to perform a device operation that is described in the user manual appear to have been ignored and are not taught by the cited references. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejection is improper, and Applicant accordingly requests that the rejection be withdrawn.

Dependent Claims 6-11, 13, 14, 16-20, 22, 26, and 27 depend from independent Claims 1 and 15, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the asserted combination of Miller and Back. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the above remarks made in connection with the independent claims. These dependent claims include

all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 6-11, 13, 14, 16-20, 22, 26, and 27 are also patentable over the asserted combination of Miller and Back.

Moreover, the § 103(a) rejection is further traversed because the asserted modification of Miller would improperly undermine the teachings of Miller. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01(V). Miller is directed to providing a user with the ability to control the initiation and replay of further functions associated with a book (paragraph [0005], last sentence). Modifying Miller to automatically perform additional functions associated with the book based upon the page the user’s book is open to, as taught by Back, would remove the user’s control over the additional functions. Also, the assertion that Miller’s book would be modified “to execute the software enabling the electronic media stored to be displayed on the computing device” is illogical since Miller already teaches allowing “the user to positively direct the computing device 24 to play electronic media stored on an electronic storage device or medium” (cited paragraph [0017]). Since the proposed modification of Miller is illogical and would improperly undermine the teachings of Miller, the proposed modification fails to support a *prima facie* § 103(a) rejection. Applicant accordingly requests that the rejection be withdrawn.

It should be noted that Applicant does not acquiesce to the Examiner’s statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant’s invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner’s characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOL.221.WUS) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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